

### REMARKS

This amendment is in response to the Office Action of April 13, 2004, which rejected claims 1-7 under 35 U.S.C. Section 102(b) as being anticipated by Paraschac, U.S. Statutory Invention Registration H1745. The Office Action further rejected claims 1-7 based on the judicially created doctrine of obviousness-type double patenting over claims 1-11 of U.S. Patent No. 6,517,536. Of the claims of the present invention, claims 1 and 3 are independent, dependent claims 2 and 6 depend from claim 1 and dependent claims 4, 5 and 7 depend from independent claim 3.

Independent claim 1 is directed to a device for clamping and ablating cardiac tissue having features which are not disclosed or suggested by the cited reference. Claim 1, in particular, comprises first and second handle members, and first and second jaw members associated with the first and second handle members, respectively. The jaws are movable by the handle members between a first open position and a second clamped position in which the jaws are substantially parallel. At least portions of the jaws are parallel through a range of clamping spacing. A first elongated electrode extends along a portion of the first jaw member and a second elongated electrode extends along the portion of the second jaw member. The first elongated electrode has a width and the portion of the jaw member includes a clamping surface having a width greater than the first electrode. A portion of the clamping

surface is located on each side of the first electrode. The second elongated electrode and the second jaw member have comparable requirements. The electrodes are in face-to-face relationship and are adapted to be connected to an RF energy source so that when activated, the first and second electrodes are opposite polarity.

Independent claim 3 is generally directed to a tissue grasping apparatus and includes, inter alia, first and second parallel grasping jaws. Each jaw further includes an elongated electrode and a clamping surface which are in face to face relation with the electrode and clamping surface of the other jaw. Each elongated electrode has a width less than the width of the respective clamping surface and is flanked by a portion of the respective clamping surface.

Claims 1-7 are respectfully believed to contain features which are not disclosed or suggested by the cited reference to Paraschac. It is presumed in the Office Action that the device shown in Figs. 3 of the Paraschac reference teaches the combination of features set forth in claims 1-7. In the Office Action, particular reference is made to reference numbers 21 and 22 in Fig. 3 which corresponds to first and second electrodes of one embodiment of Paraschac's bipolar coagulation device having first and second jaws.

Applicants respectfully submit that the device shown in Fig. 3 does not show or suggest the features recited in claims 1-7. In

Fig. 3, each jaw has a series of wide, spaced-apart respective electrodes 21 and 22 that effectively form the full clamping width of each jaw, in contrast to the narrower elongated electrode set forth in the pending claims. Paraschac's electrodes 21 and 22 are each disclosed as forming opposed planar grasping surfaces 27 and 39, respectively, which span virtually the entire width of the jaw. Thin insulators 26 and 28, respectively, surround the outer surfaces of the electrodes but do not form any part of the grasping surfaces 27 and 39. This arrangement is unlike the arrangement set forth in claims 1-7, in which each elongated electrode has a width less than the width of the respective clamping surface (or the clamping surface has a width greater than the width of the respective electrode).

In further contrast to the statements in the Office Action, the first and second electrodes 21 and 22 in Fig. 3 also do not describe or suggest an electrode arrangement in which each electrode is located on the respective jaw and flanked by portions of the jaw clamping surface (or with portions of the clamping surface on both sides of the electrode). Rather, in Fig. 3 of Paraschac, the electrodes comprise the entire clamping or grasping surface. Therefore, the device shown in Fig. 3 of Paraschac does not teach or suggest the subject matter of claims 1-7.

If the Office Action was intended to compare the device shown in Fig. 2 of Paraschac to the claims, this device also fails to

teach or suggest the electrode/jaw arrangement as recited in the claims. In the device of Fig. 2, the first and second electrodes 11 and 12 are disposed along the three exterior sides of the respective jaw thereby forming at least the full width of each jaw portion, in contrast to the narrower elongated electrodes recited in the claims. The respective insulators 16 and 18 are positioned between the electrodes 11 and 12 so that the electrodes clearly are not in face-to-face relationship. A third electrode 17 in Fig. 2 is also not in face-to-face relationship with either of the first and second electrodes 11 and 12. Instead, the third electrode 17 faces the insulator 18 of the lower jaw as viewed in Fig. 2 and the lower jaw lacks any electrode positioned in face-to-face relationship with the third electrode 17. Thus, the embodiment of Fig. 2 also fails to teach or suggest the subject matter of claims 1-7.

Further, other embodiments shown in Paraschac at Figs. 4-11 also fails to teach or suggest the subject matter of the claims. These embodiments teach a similar construction to that shown in Fig. 3 except for a knife channel 143 for receiving a knife 122. In this regard, the embodiments of Figs. 4-11 also fails to teach or suggest the electrode/jaw arrangement as recited in claims 1-7 for similar reasons as discussed above, and, thus, claims 1-7 should be allowable.

In response to the rejection of claims 1-7 based on the judicially created doctrine of obviousness-type double patenting, applicant encloses an executed Terminal Disclaimer, which should obviate this double patenting rejection. This submission is made to remove the double patenting rejection without admission as to the merits of the rejection.

Enclosed with this response is the Terminal Disclaimer fee of \$55.00 as dictated by 37 C.F.R. 1.20(d). If any addition fee is required, authorization is hereby given charge to deposit account Deposit Account 50-1039 that additional amount.

Also enclosed is an Information Disclosure Statement which lists a patent recently cited by the Examiner in a related application.

For the above reasons, it is respectfully submitted that claims 1-7 are not described or suggested in the cited reference. Reconsideration and allowance of these claims are respectfully requested.

Respectfully submitted,

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